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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,452	12/31/2003	Carol L. Shillinglaw	GEMS8081.208	9840

27061 7590 04/04/2007  
ZIOLKOWSKI PATENT SOLUTIONS GROUP, SC (GEMS)  
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PORT WASHINGTON, WI 53074

EXAMINER
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BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3628

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/04/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/749,452

Applicant(s)

SHILLINGLAW ET AL.

Examiner

Igor N. Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Amendment received on 1/18/07 is acknowledged and entered. Claims 24-43 are currently pending in the application.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 39-43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the claim 39 is directed to non-statutory subject matter because a "signal" is not considered statutory. A signal (in a carrier wave) is not a tangible thing. A signal is not something that is eligible for patent rights.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 24-35 and 37-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oyagi et al. (US 6,199,193).**

Oyagi et al. teach a computer-implemented method, system and computer-readable medium having instruction embedded therein for causing a computer to

implement said method for software development and software design evaluation server, comprising:

**As per claims 24-35 and 37-43,**

providing a feedback inputting graphical user interface (GUI) (Abstract; column 2, lines 8-48);

receiving user feedback on a business plan wherein the user feedback includes one or more user responses regarding the business plan (Abstract; column 2, lines 8-48; column 6, lines 29-38);

at the centralized facility, determining feedback characteristics of the user feedback displaying, in near real-time, the feedback characteristics on an internal business plan GUI (column 2, lines 8-48; column 6, lines 29 – column 7, line 33);

assigning at least one of a category, a region, a status, and an administrator to each user response (column 6, lines 29-63);

displaying, on the business plan GUI, the category, the region, a user response author, text of the user response, and, if any, a reply to the user response (column 6, lines 29 – column 7, line 33);

wherein the business plan GUI is accessible via one of an intranet, Internet, and extranet and is only viewable by an authorized user (column 3, lines 5-14; column 5, lines 23-27; column 6, lines 29-38; column 7, lines 52-56; column 8, lines 50-52), and

wherein the feedback characteristics include at least one of a positive response, and a negative response (Fig. 5; column 5, lines 36-50; column 6, lines 7-9).

Oyagi et al. does not explicitly teach that said users include *users of a newly integrated business unit*. However, the fact that whether said users include *users of a newly integrated business unit*, or not, cannot affect the method steps recited. Therefore, information as to that said users include *users of a newly integrated business unit* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

MPEP 2106 (II) (C) states: "*Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.*"

Also, Oyagi et al. does not explicitly teach that said business plan *integrates the newly integrated business unit within a business enterprise*. However, the fact that whether said business plan integrates the newly integrates business unit within a business enterprise, or not, cannot affect the method steps recited. Therefore, information as to that said business plan *integrates the newly integrates business unit within a business enterprise*, and that the business plan *is an implemented business plan*, is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). MPEP 2106 (II) (C) states: "*Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.*"

Also, Oyagi et al., while teaching receiving negative and positive responses, does not explicitly teach that said received responses include neutral responses and too-early-to-tell responses, and that the business plan is an implemented business plan.

However, based on common sense, it is within ability of one having ordinary skill in the art to come up with variations of possible feedbacks.

Therefore, it would have been an obvious matter of design choice to modify Oyagi et al. to include that user's responses include neutral responses and too-early-to-tell responses, because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of Oyagi et al. would perform the invention as claimed by the applicant with user's responses being of any type.

**As per claims 37 and 38**, Oyagi et al. teaches said system configured to displaying a personal information GUI, configured to allow a user to input his/her ID and password (column 6, lines 29-38).

Oyagi et al. do not specifically teach that said personal information includes a name, an address, a telephone number, a country, a zip code, a region, an email address and a sales representation name.

However, based on common sense, it is within ability of one having ordinary skill in the art to come up with variations of personal information.

Therefore, it would have been an obvious matter of design choice to modify Oyagi et al. to include that the personal information GUI configured to allow a user to input contact information, because it would advantageously allow the user to operate with any desirable for the user type of personal information, thereby providing convenience to the user.

**Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oyagi et al. in view of Eringis et al. (US 2003/0202638).**

Claim 36. Oyagi et al. teaches all the limitations of claim 36, except specifically teaching that the processing unit is further programmed to display a user drill-down menu to enable the integration leader to identify personnel roles in relation to the implemented business plan wherein the personnel roles are automatically linked to the implemented business plan.

Eringis et al. teaches a system for implementing a business plan for testing hardware system, including a processor and a graphical user interface (GUI), wherein said system is configured to input various evaluation criteria including organization/team chart, defined responsibilities and roles; list of account managers assigned; the process for addressing roles and responsibilities of account managers; specific teams and roles are responsible for updating documentation; process of reviewing, and integrating teams for shared knowledge is in place; and available different means of addressing questions/concerns, other account manager contact information available if primary

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account manager is absent [0478]. As per using said menu per se, GUI suggest the use of said menu.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Oyagi et al. to include that said processing unit is further programmed to display a GUI to enable the integration leader to identify personnel roles in relation to the implemented business plan wherein the personnel roles are automatically linked to the implemented business plan, as suggested in Eringis et al., because it would advantageously allow to implement a comprehensive, effective, efficient, and reliable testing or surveying methodology, suitable for a variety of environments, jurisdictions, and particular needs, as specifically stated in Eringis et al. [0008].

### ***Response to Arguments***

Applicant's arguments filed 1/18/07 have been fully considered but they are not persuasive.

In response to applicant's argument that claims rejected under 35 U.S.C. 101 have to be withdrawn, the examiner maintains that the claimed invention is directed to non-statutory subject matter. 35 U.S.C. 101 reads as follows: "Whoever invents or discovers any new and useful *process, machine, manufacture, or composition of matter*, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title". Claim 39 recites "a computer data signal embodied in a carrier wave". The carrier wave is not a *process, machine, manufacture, or composition of matter*. Therefor, the claim is directed to non-statutory subject matter and is not considered statutory.

In response to applicant's argument that information as to that "said users include users of a newly integrated business unit"; and that "said business plan integrates the newly integrated business unit" are functional limitations, it is noted that the fact that whether said users include users of a newly integrated business unit, or

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not, cannot affect the method steps recited. Therefore, information as to that said users include *users of a newly integrated business unit* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). MPEP 2106 (II) (C) states: "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation."

In response to applicant's argument that there is no suggestion to modify Oyagi et al. to include that user's responses include neutral responses and too-early-to-tell responses, it is noted that Oyagi et al. teaches teaching *receiving negative and positive responses*. As per specific variations of said responses, the common sense dictates that it is within ability of one having ordinary skill in the art to come up with variations of possible feedbacks. As such, any received responses would be obvious variations of the disclosed received responses without affecting the method step recited.

In response to applicant's argument that may rely on common sense without pointing to some concrete evidence in the record to support a finding, it is noted that Oyagi et al. does disclose *receiving negative and positive responses*. The common sense was relied upon to come up with possible variations of responses.

The remaining applicant's arguments essentially repeat the arguments presented above; therefore, the responses presented by the examiner above are equally applicable to the remaining applicant's arguments.



**Conclusion**

Applicant's arguments filed 1/18/07 have been fully considered but they are not persuasive.

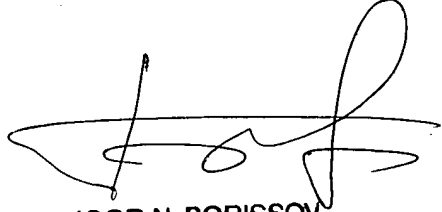
**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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3/27/2007



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PRIMARY EXAMINER